Attorney Docket No. JP920020220US1 (7161-317U)   **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of   :   Customer Number: 46320
                                      :
Yuhji YAMASHITA, et al.   :   Confirmation Number: 2216
                                      :
Application No.: 10/673,812   :   Group Art Unit: 2143
                                      :
Filed: September 29, 2003   :   Examiner: M. Fearer
                                      :
For: RELAY PROCESSING APPARATUS, CONTROL METHOD AND PROGRAM
       THEREFOR, AND TERMINAL CONTROL SERVER

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

        This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S

ANSWER dated March 5, 2009.

        The Examiner's response to Appellants' arguments submitted in the Appeal Brief of

December 8, 2008, raises additional issues and underscores the factual and legal shortcomings in

the Examiner's rejection.   In response, Appellants rely upon the arguments presented in the

Appeal Brief of December 8, 2008, and the arguments set forth below.

1   **REMARKS**

2

3   Appellants have compared the statement of the rejection found on pages 3-14 of the

4   Examiner's Answer with the statement of the rejection found on pages 2-13 of the Third Office

5   Action. Upon making this comparison, Appellants have been unable to discover any substantial

6   differences between the respective statements of the rejection. As such, Appellants proceed on

7   the basis that the Examiner's sole response to Appellants' Appeal Brief is found on pages 14-20

8   of the Examiner's Answer in the section entitled "Response to Argument."

9

10   Referring to the paragraph spanning pages 14 and 15 of the Examiner's Answer, the

11   Examiner makes the following assertion: "[t]he control request processor of the Application is

12   read as an EJB container in the reference." Appellants' analysis in the Appeal Brief is based

13   upon a reading of the bottom of page 17 of the Third Office Action that the servlets are being

14   alleged by the Examiner as corresponding to the claimed control request processor. As such, the

15   Examiner's failure to <u>clearly</u> indicate the features being relied in rejecting the claims has caused

16   Appellants to reevaluate the Examiner's analysis. In this regard, the Honorable Board is asked to

17   consider the Examiner's analysis on pages 4 and 5 of the Examiner's Answer (the same analysis

18   presented on page 4 of the Third Office Action) and identify how it would be possible for

19   anybody reading the Examiner's analysis to come to the conclusion that the Examiner is relying

20   upon an "EJB container" to teach the claimed "control request processor."

21

22   Within the same paragraph of the Examiner's Answer, the Examiner made the following

23   additional assertion: "[t]he control program of the Application is read as a web container in the

1   reference." In response, reference is made to the paragraph spanning pages 14 and 15 of the

2   Third Office Action in which the Examiner "explicitly" identified the claimed features allegedly

3   corresponding to the claimed "control program." This passage, however, is entirely silent as to

4   any mention of a "web container." As such, the Examiner has again presented an inconsistent

5   analysis.

6

7   Within the same paragraph[1] of the Examiner's Answer, the Examiner made the following

8   assertion:

9   and for transmitting to said terminal request processor <u>a notification that said first command has</u>
10   <u>been received</u> (page 67) (emphasis added)
11
12   Referring to page 18 of the Third Office Action, which included the Examiner's clarification as

13   to what allegedly disclosed the claimed "a notification that a first commend has been received,"

14   although the Examiner refers to page 16 of Vilaghy, the Examiner did not refer to page 67 on

15   page 18 of the Third Office Action. As such, the Examiner has again presented analysis that is

16   not consistent with the Examiner's prior analysis.

17

18   Referring to the paragraph spanning pages 16 and 17 of the Examiner's Answer, the

19   Examiner made the following additional assertion: "[t]he terminal request processor of the

20   Application is read as a WebServer Plugin in the reference."

21

22   On page 17 of the Examiner's Answer, the Examiner made the following assertions:

23   responsive to the reception notification, for <u>returning the first command to said HTTP server</u>
24   <u>program</u>, and means in the HTTP server program for <u>returning said command to the terminal in</u>
25   <u>said HTTP response</u> issued for said HTTP request (pages 124 and 154).
26
27   Referring to page 19 of the Third Office Action, which included the Examiner's clarification as

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[1] The Examiner also cites to page 67 regarding the same limitation on page 17 of the Examiner's Answer.

1   to what allegedly disclosed the claimed "returning the first command to the HTTP server

2   program" and "returning the command to the terminal in the HTTP response," although the

3   Examiner refers to page 134 and Figure 10-4 of Vilaghy, the Examiner does not refer to pages

4   124 and 154. As such, the Examiner has yet again presented analysis that is not consistent with

5   the Examiner's prior analysis.

6

7   Based upon the Examiner's numerous clarifications, the chart presented on page 10 of the

8   Appeal Brief is revised as follows:

Claimed Feature	Teaching within Vilaghy
control program	web container; Fig. 10-3 and pg. 133
terminal	Web terminal translation program, DFHWBTTA, pg. 156 and Fig. 13-5
HTTP server program	HTTP server; Fig. 8-1 and pg. 113
terminal request processor	WebServer Plugin; Fig. 10-3 and pg. 133
control request processor	EJB container; Fig. 10-3 and pg. 133
notification that a first command has been received	pg. 67
returning the first command to the HTTP server program	pg. 124 and 154
returning the command to the terminal in the HTTP response	Same as immediately above.

9

10   Considering that the Examiner has completely modified how the Examiner is viewing the

11   applied prior art, Appellants will focus on just a few of the claimed limitations to establish the

12   Examiner's error:

13

1   As claimed, the control request processor includes means for transmitting to the terminal

2   request processor a notification that said first command has been received. Based upon the

3   Examiner's new analysis, (i) the control request processor is disclosed by the EJB container, (ii)

4   the terminal request processor is disclosed by the WebServer Plugin, and the "notification that a

5   first command has been received" is disclosed within page 67 of Vilaghy.

6

7   A review of page 67 of Vilaghy fails to yield any mention of the EJB container

8   communicating anything to a WebServer Plugin. In fact, the WebServer Plugin is not mentioned

9   in page 67 and the only communications described with regard to EJBs are that "EJBs can

10   connect to back-end systems using connectors." As such, Appellants are entirely unclear as to

11   how this passage teaches the claimed "notification that a first command has been received."

12

13   As claimed, the terminal request processor includes means, responsive to the reception

14   notification, for returning the first command to said HTTP server program. Based upon the

15   Examiner's new analysis, (i) the reception notification is disclosed within page 67, (ii) the

16   terminal request processor is disclosed by the WebServer Plugin, (iii) the HTTP server program

17   is disclosed by the HTTP Server, and (iv) the "returning the first command to the HTTP server

18   program" is disclosed somewhere within pages 124 and 154 of Vilaghy. As such, the Examiner

19   has not properly characterized the scope and content of the applied prior art.

20

21   As already noted above, exactly what within Vilaghy discloses the notification that a first

22   command has been received (i.e., the reception notification) has not been established. The only

23   discussion of a Server Plugin is found on the very top of page 124, which states:

1　　　The HTTP server compares the user specified value myservlets in the URL with a matching
2　　　Service directive in the httpd.conf file, recognizes that this is a servlet or JSP request, and passes it
3　　　forward to the WebSphere Application Server Plugin.
4
5　Although this passage refers to passing information to the Server Plugin, this passage is silent as

6　to what the WebServer Plugin sends.

7

8　　　Referring to page 154, Vilaghy teaches that the WebServer Plugin passes a EXCI request

9　to a CICS region. However, entirely absent from page 154 is a teaching that the WebServer

10　Plugin returns a first command to the HTTP server. As such, the Examiner has not properly

11　characterized the scope and content of the applied prior art.

12

13　　　As claimed, the HTTP server program includes means for returning the command to the

14　terminal in the HTTP response issued for the HTTP request. As discussed in the chart, the

15　Examiner also cited pages 124 and 154 of Vilaghy as teaching these limitations. Page 154 does

16　not describe the HTTP response issued for the HTTP request. As such, this page does not appear

17　to be relevant to the claimed limitations at issue. Although Figure 9-2 on page 124 illustrates a

18　response that issued in response to a request, page 124 is completely silent as to the contents of

19　this response. As such, the Examiner has not properly characterized the scope and content of the

20　applied prior art.

21

22　――

23　　　On page 11, line 22 through page 13, line 7 of the Appeal Brief, Appellants presented

24　several arguments regarding the sufficiency of the Examiner's obviousness analysis. For

25　example, Appellants argued that the Examiner has failed to properly ascertain the differences

26　between the prior art and the claims at issue, which is one of the Graham factual inquiries. The

1   Examiner's response to these arguments is found in three separate instances on pages 17-20 of

2   the Examiner's Answer. However, as will discussed in greater detail below, these three separate

3   responses are almost identical.

4

5   Referring to the paragraph spanning pages 17 and 18 of the Examiner's Answer, the

6   Examiner asserted the following:

7   Vilaghy et al. discloses a relay processing apparatus for relaying communications
8   between <u>a web container (read as a control program)</u> that generates control commands for a
9   terminal and a process for an HTTP server program that returns to said terminal a command
10   constituting an HTTP response to a HTTP request received from said terminal, comprising: a
11   terminal request processor for initiating said control program upon the reception of a function call
12   from said HTTP server program that initially received said HTTP request from the terminal (<u>page</u>
13   <u>23</u>); and an <u>EJB container (read as a control request processor)</u> for receiving from said control
14   program a first command generated as a response to the function call, and for transmitting to said
15   terminal request processor a notification that said first command has been received (<u>page 67</u>) , and
16   means in the <u>web server plugin (read as a terminal request processor)</u> responsive to the reception
17   notification, for returning the first command to said HTTP server program, and means in the
18   HTTP server program for returning said command to the terminal in said HTTP response issued
19   for said HTTP request (<u>pages 124 and 154</u>). (emphasis added)
20
21 The above reproduced "response" to Appellants' response is merely a reproduction of the

22   analysis that the Examiner has presented in each of the first three Office Actions and in the

23   Examiner's Answer with a couple of modifications.

24

25   This first modifications is that where the Examiner previously reproduced language from

26   Vilaghy, the Examiner is now just citing the page number (e.g., "page 67," "page 23," "pages 124

27   and 154"). The Examiner's other set of modifications involving replacing a previously

28   identification of a claim term (e.g., "control program") with the phrase comparing the claim term

29   to the teaching in Vilaghy (e.g., "a web container (read as a control program)"). The Examiner

30   did this for the claimed (i) control program, (ii) control request processor; and (iii) terminal

31   request processor. Other than these slight modifications, the Examiner's analysis is essentially

32   identical to what is found in each of the first three Office Actions and in the Examiner's Answer

1

2   As a result of the Examiner presenting essentially identical analysis to what the Examiner

3 has already presented before, the Examiner has failed to address Appellants' arguments.

4 Specifically, the Examiner has failed to ascertain the differences between Vilaghy and the

5 claimed invention.

6

7   Referring to the paragraph spanning pages 18 and 19 of the Examiner's Answer, this

8 paragraph is identical to the paragraph spanning pages 17 and 18 of the Examiner's Answer and

9 addressed above. Referring to the paragraph spanning pages 19 and 20 of the Examiner's

10 Answer, this paragraph is also identical with the exception of the final assertion on page 20 that:

11   Though found in different embodiments of the Vilaghy et al. reference, they are all from the same
12   invention and would have been obvious to combine for the purpose of passing web pages from a
13   backend server to a terminal via a secure gateway.
14
15 Apparently, the Examiner believes that a combination of all of the different embodiments

16 described by Vilaghy would have been obvious since "they are all from the same invention."

17

18   Although the Examiner has failed to allege that Vilaghy teaches all of the claimed

19 limitations, for sake of argument, Appellants will proceed on the basis that the Examiner made

20 such an argument. If so, the rejection would have been a rejection under 35 U.S.C. § 102 for

21 anticipation. However, a prior art reference which contains a broad disclosure requiring

22 guessing, testing, speculation or "picking and choosing" from a broad disclosure does not

23 constitute an identical description of a claimed invention within the meaning of 35 U.S.C. § 102.

24 Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc., 976 F.2d

25 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); Air Products & Chemicals, Inc. v. Charles S. Tanner

26 Co., 219 USPQ 223 (D.S.C. 1983).; In re Arkley, 455 F.2d 586, 172 USPQ 524 (CCPA 1972).

1   What the Examiner's analysis essentially proposes, however, is picking and choosing certain

2   elements from different teachings within Vilaghy and combining them in the manner claimed,

3   which is exactly what is prohibited in the case law discussed above.

4

5   Turning to the Examiner's alleged motivation for this combination, the Examiner asserted

6   that it "would have been obvious to combine for the purpose of passing web pages from a

7   backend server to a terminal via a secure gateway." Appellants respectfully submit that the

8   Examiner's proposed combination has no more relevance to "passing web pages from a backend

9   server to a terminal via a secure gateway" than an improved intermittent windshield wiper motor

10   has to the handling performance of an automobile. To achieve the alleged purpose identified by

11   the Examiner requires a secure gateway connected to a server and backend server and does not

12   require any claimed elements identified by the Examiner.

13

14   Referring to page 7 of the Appeal Brief, it is uncontroverted by the Examiner that the

15   Examiner's is relying upon Rationale (G) within the Examination Guidelines for Determining

16   Obviousness. As such, since the Examiner is employing TSM jurisprudence, the Examiner is

17   required to establish a reasonable expectation of success as to a particular benefit. However, the

18   Examiner's proposed combination does not provide this benefit. Instead, the Examiner's

19   proposed benefit results from elements that are separate from the proposed combination. As

20   such, the Examiner has failed set forth the requisite findings to establish a prima facie case of

21   obviousness.

22

For the reasons set forth in the Appeal Brief of December 8, 2008, and for those set forth herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. § 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: May 5, 2009   Respectfully submitted,

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